

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID J. STEIDINGER and MARK S. STEIDINGER

Appeal No. 1999-0911
Application No. 08/852,708

ON BRIEF

Before CALVERT, FRANKFORT, and GONZALES, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 52 to 59, all the claims remaining in the application.

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The claims on appeal are drawn to a method of handling a continuous, elongated web, and are reproduced in the appendix of appellants' brief.

The prior art applied in the final rejection is:

Klaeser et al. (Klaeser) 1989	4,838,982	Jun. 13,
Otruba 1995	5,413,651	May 09,
Steidinger et al. ¹ (Steidinger) 1995	5,441,796	Aug. 15,
		(filed June 10, 1994)

The admitted prior art on page 1 to page 3, line 15, of appellants' specification (APA).

The appealed claims stand finally rejected under 35
U.S.C.

¹ Since the patentees of this patent appear to be the same persons as the present appellants, and the patent was issued after the filing date of appellants' parent application, it seemingly would not constitute prior art against appellants. However, since appellants have not argued this point, the patent will be considered in evaluating the merits of the rejections.

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§ 103(a) as unpatentable over the following combinations of prior art:²

- (1) Claims 52 and 53, APA in view of Steidinger;
- (2) Claims 54, 55, 58 and 59, APA in view of Steidinger and Otruba;
- (3) Claims 56 and 57, APA in view of Steidinger and Klaeser.

Rejection (1)

The argument with regard to this rejection concerns the final step of claim 52, which reads:

providing sufficient length in said section of said web between said feed means and said cut line to reduce the tensile stress in said section of said web between said feed means and said cut line to prevent tears in said web incident to severing of said web.

The examiner takes the position that it would have been obvious to modify the method of the APA to include this step in view of Steidinger. As stated by the examiner at pages 4 to 5 of the Answer:

² A rejection of claims 52 to 59 under 35 U.S.C. § 112, first paragraph (non-enablement), has been withdrawn (removed) by the examiner (Answer, page 9).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Appellants' admitted prior art that length in the web in a section between the feed means and the first cylinder is greater than the direct distance between the location at which the web leaves the feed means and the location at which the blade contacts the first cylinder using support rollers because Steidinger et al. teach that such a web feed path is well-known and it is [sic: would have been] obvious to replace one feed path with an art recognized alternative feed path used for the same purpose of moving a web from a feed means to a vacuum cylinder for cutting.

Since the method of Appellants' admitted prior art in view of Steidinger et al. is the same as presently claimed, it is reasonable to suggest that between the feed means and the cut line there will be a reduction in tensile stress which will prevent the tears in the web incident to severing the web to the same degree as is present in the pending claims, although this may not be specifically recited.

Although the examiner acknowledges that Steidinger does not indicate a reason for the distance shown between feed means 20 and the location at which the blade on cylinder 27 contacts cylinder 28 (i.e., contacts web 19) (Answer, page 4), he appears to take the position at page 10 of the Answer that the combination of the APA and Steidinger would inherently meet the above-quoted last step of claim 52 because appellants' specification (at pages 10 and 11)

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indicates that "sufficient" includes increasing the length of the web in the section between the feed means and the first cylinder to be greater than the direct distance between the location at which the web leaves the feed means and the location at which the blade contacts the first cylinder. (Underlining omitted)

We do not consider the examiner's position to be well taken. Contrary to the examiner's above-quoted statement, appellants do not disclose that every apparatus in which the length of the web between the feed means and the cutoff point on the vacuum cylinder is greater than the direct distance between those points will provide a sufficient length to prevent tears, as called for by claim 52. Rather, they disclose at page 11, lines 6 to 13:

By advantageously adjusting the web length between the point of cutoff on the vacuum cylinder 14 and the feed roller 12 from approximately 38" or less to a length of approximately 60" or more, the tension spike and transverse edge tearing may be reduced. These web lengths are not specified exactly because of interaction with the following described techniques and also a variability in the physical characteristics of transfer tapes applied or other webs being severed.

Thus, the mere fact that the Steidinger web feed path is longer than the direct path between feed means 20 and cylinder 27 does not necessarily mean that it is sufficiently long to

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prevent tears. Moreover, Steidinger does not disclose any dimensions or other information from which it may be inferred that the web feed path is sufficiently long to prevent tears. Accordingly, it cannot be concluded that the combination of the APA and Steidinger would result in a method which would inherently meet the last step of claim 52. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency, and in this case, absent inherency, a **prima facie** case of obviousness has not been established. Cf. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ 1955, 1956 (Fed. Cir. 1993).

Rejection (1) therefore will not be sustained.

Rejections (2) and (3)

These rejections will not be sustained, since the additional references applied, Otruba and Klaeser, do not supply the deficiencies in the APA - Steidinger combination discussed above.

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Conclusion

The examiner's decision to reject claims 52 to 59 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
CHARLES E. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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JOHN F. GONZALES)	
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